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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77830997
Applicant	TROPICAL SEAS, INC.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Trademark Application of:
Tropical Seas, Inc.

Mark: **REEF SAFE**

Serial No.: 77/830,997

Filing Date: September 21, 2009

Examining Attorney: Aretha Somerville, Esq.
Law Office 107

APPLICANT'S APPEAL BRIEF

Pursuant to a Notice of Appeal filed with and acknowledged by the Trademark Trial and Appeal Board on October 15, 2010, which was suspended and later resumed by the TTAB on November 17, 2010, Applicant Tropical Seas, Inc., by and through its undersigned counsel, files this Appeal Brief seeking approval of the application to register the mark **REEF SAFE** (Serial No. 77/830,997) on the Principal Register.

Background

On September 21, 2009, Applicant filed an application for the mark **REEF SAFE** in plain type for use on “sun care lotions,” in International Class 3, based on Applicant’s use of this mark on these goods in interstate commerce since at least as early as March 1, 1996.

In the first Office Action dated December 17, 2009, the Examining Attorney refused to register the subject mark because of a purported likelihood of confusion with the marks in U.S. Registration Nos. 2,579,774; 1,166,023 and 2,895,321. No other issues were raised. Applicant responded to the first Office Action on February 19, 2010, arguing that there is no likelihood of

confusion between the subject mark and the cited marks, but the Examining Attorney was not persuaded.

In the second and final Office Action dated April 15, 2010, the Examining Attorney maintained her refusal to register the subject mark due to the purported likelihood of confusion with Reg. Nos. 2,579,774; 1,166,023 and 2,895,321. On October 15, 2010, Applicant requested reconsideration of the final refusal and concurrently filed a Notice of Appeal with the TTAB, which was suspended pending the outcome of the request for reconsideration.

On November 15, 2010, the Examining Attorney was persuaded to withdraw her refusal as to Reg. No. 2,895,321, but denied the request for reconsideration as to Reg. Nos. 2,579,774 and 1,166,023. Accordingly, the TTAB resumed the appeal on November 15, 2010. Applicant submits this Appeal Brief in support of registration of the mark **REEF SAFE** in Class 3 on the Principal Register.

Arguments

Applicant seeks registration of the mark **REEF SAFE** for use on “sun care lotions,” in International Class 3. The Examining Attorney argues that the subject mark is confusingly similar to the marks **REEF**, used on “sun block preparations and sun screen preparations,” and **REEF OIL (Stylized)**, used on “suntan lotion.” Below, Applicant summarizes each the Examining Attorney’s arguments, as well as its own arguments and evidence, to prove that there is no valid reason to refuse registration of the subject application.

Applicant’s prior arguments and evidence, including all attachments, are incorporated herein by reference and are made part of this brief in their entireties.

In the Office Action dated December 17, 2009, the Examining Attorney noted that “applicant see[k]s registration of the mark **REEF SAFE** for ‘sun care lotions.’ The cited marks are **REEF OIL** [(Stylized)] for ‘suntan lotion’ and **REEF** for ‘sun block preparations and sun screen preparations...” It is notable that the Examining Attorney failed to conduct any actual comparison of the marks, but merely concluded that “[c]onsumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark.”

In making this argument, the Examining Attorney ignored *half* of Applicant’s mark – the word **SAFE** – and its effect on consumers. When comparing marks in a likelihood of confusion analysis, the marks must be considered in their entirety rather than dissected into their component parts for comparison. T.M.E.P. § 1207.01(b)(i); *See, for example, In re Nat’l Data Corp.*, 753 F.2d 1056, 224 U.S. P.O. 749 (Fed. Cir. 1985); *In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (the Board inappropriately analyzed the **VARGA GIRL** mark by stressing **VARGA** and discounting **GIRL**).

In *In Re Hearst*, 982 F.2d at 494, the Court confirmed that it was necessary to review the entire appearance, sound, and commercial impression of the mark so as not to change the mark or diminish the value and contribution of individual terms to the overall composite mark. The commercial impression of a trademark is derived from it as whole, not from its elements separated and considered in detail, and so the mark needs to be considered in its entirety. *Estate of P.P. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-6 (1920).

In the instant case, Applicant has argued that **REEF SAFE** is a composite mark that is more than the sum of its individual parts. It has an obviously unique appearance and sound that is not shared by either of the cited mark. Importantly, Applicant has added the distinctive term

SAFE to its mark **REEF SAFE**. The entire mark **REEF SAFE** also has a unique commercial impression that is very dependent upon both the word REEF and the word SAFE. Specifically, Applicant's mark **REEF SAFE** alludes to eco-friendliness; the combination of the words REEF and SAFE conjure in the minds of consumers a so-called "green" or environmentally friendly impression. This commercial impression is further amplified by today's ever increasing "green" movement. Consumers of Applicant's products are likely to understand that the products will be environmentally friendly and unlikely to cause ecological damage to fragile reefs and other aquatic life. In contrast, the cited marks are devoid of the word SAFE or any other component that even arguably alludes to eco-friendliness, are also devoid of this eco-friendly or "green" commercial impression.

Clearly, the shared use of the term REEF does not automatically result in a likelihood of confusion, as suggested by the Examining Attorney. *See Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404 (C.C.P.A. 1975) (COUNTRY VOGUES for ladies' and misses' dresses is not confusingly similar to VOGUE magazine). This is even more so because the term REEF is commonly used by third parties, which supports the conclusion that consumers have become well accustomed to differentiating between marks containing the term REEF for water- and ocean-related products, and thus, are unlikely to be confused by marks containing this term. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626 (8th Cir. 1987) ("consumer confusion can be found unlikely if the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related"). Applicant submitted evidence of several registrations that contain the term REEF used on water- and ocean-related goods, which strongly supports the argument that the term REEF alone is not enough to result in

a likelihood of confusion amongst any of these various marks, and moreover, that combo of REEF and a distinctive term allows consumers to differentiate between these various marks all containing the same term REEF.

The Examining Attorney failed to give proper consideration to the foregoing arguments. In the Office Action dated April 15, 2010, the Examining Attorney replied that “[w]hile [Applicant’s] mark contains the additional word SAFE, the mark **REEF SAFE** in its entirety does not convey a significantly different commercial impression. Furthermore, purchasers are not likely to perceive SAFE as a distinguishing source of goods.” To the contrary, Applicant’s foregoing arguments provided sufficient evidence that its mark does, in fact, convey a significantly different commercial impression than that of the cited marks **REEF** and **REEF OIL (Stylized)**.

The Examining Attorney also replied that “the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer.” But such a statement fails to appreciate that Applicant is hardly a “newcomer,” since it has been using the mark **REEF SAFE** since at least as early as 1996. In that time, there have been no known instances of actual confusion with the cited marks. The unique appearance, sound and commercial impression of the mark **REEF SAFE** ensures that consumers can distinguish Applicant and its goods from those goods offered under either of the cited marks despite any potential overlap in the respective goods.

Moreover, Applicant is using the mark **REEF SAFE** on other products, namely, clothing, which allows the public to associate the mark with Applicant. *See J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991). Consumers will likely recognize Applicant as the source of any **REEF SAFE** product, thereby negating the likelihood of confusion with the cited marks.

The Examining Attorney also replied that “there is no evidence presented by the applicant that REEF is weak with respect to ‘sun care lotions.’” There is, however, sufficient evidence that REEF is weak with respect to water- and ocean-related products, including but not limited to sun care lotion, goggles, swimsuits and snorkels. The term REEF connotes an idea of the ocean and underwater activities, and products bearing this term as a mark are likely marketed to the same types of consumers and sold through the same channels of trade. Many of these prior registrations even identify identical products – for instance, OCEAN REEF swim goggles and REEF DIVER swim goggles – yet those marks co-exist on the Principal Register. There is no legal reason why those registrations can co-exist, but not **REEF SAFE** and **REEF** and **REEF OIL (Stylized)**.

On November 15, 2010, in her denial of the request for reconsideration, the Examining Attorney stated she “must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.” Applicant asserts that all of its arguments and evidence are significant and compelling with regard to the point at issue, namely, that the mark **REEF SAFE** is wholly dissimilar from the cited marks **REEF** and **REEF OIL (Stylized)**. The subject mark has such a unique commercial impression that it cannot be said to be confusingly similar to either of the cited marks, despite any potential overlap in the goods.

Conclusion

Applicant has appropriately and fully addressed each concern raised by the Examining Attorney in the first and final Office Actions. Based on the information and arguments presented, Applicant respectfully submits that there is no likelihood of confusion with Reg. Nos.

2,579,774 and 1,166,023, and therefore, requests the TTAB overturn the Examining Attorney refusal to register the subject mark.

WHEREFORE, for the reasons set forth above, Applicant respectfully requests that the subject application be approved for publication. Such favorable action is hereby earnestly solicited.

Dated: January 17, 2010

Respectfully submitted,

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